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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,412	03/30/2004	Po-Ying Chan-Hui	131.04US	5633
33603 7590 11/27/2007 MONOGRAM BIOSCIENCES 345 OYSTER POINT BLVD SOUTH SAN FRANCISCO, CA 94080			EXAMINER REDDIG, PETER J	
			ART UNIT 1642	PAPER NUMBER
			MAIL DATE 11/27/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/813,412

Applicant(s)

CHAN-HUI ET AL.

Examiner

Peter J. Reddig

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on September 10, 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-12 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 and 10-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The Amendment filed September 10, 2007 in response to the Office Action of May 9, 2007 is acknowledged and has been entered. Claims 8 and 10-12 are pending and were previously under examination. Claims 8 and 10-12 have been withdrawn from further consideration by the examiner under 37 CFR 1.142(b) as being drawn to non-elected inventions for the reasons set forth below.

2. The claims as currently constituted are directed to a method of measuring the amount of Erb-B dimers in patient cancer cells, the method comprising the steps of: isolating a patient sample containing cancer cells from a patient, wherein the patient sample is a fixed tissue sample, a frozen tissue sample, or circulating epithelial cells; and measuring an amount of each of one or more Her receptor heterodimers in the patient sample, which is a distinct invention from the invention originally presented in application Serial No. 10/813,412 which is directed to a method of selecting a patient for treatment of a cancer with one or more ErbB-dimer-acting drugs, the method comprising the steps of: isolating a patient sample containing cancer cells from a patient, wherein the patient sample is a fixed tissue sample, a frozen tissue sample, or circulating epithelial cells; measuring an amount of each of one or more Her receptor heterodimers in the patient sample; comparing each such amount to its corresponding amount from a reference sample; and selecting the patient for treatment with one or more ErbB dimer-acting drugs whenever an amount of one or more Her heterodimers from the patient sample exceeds the respective corresponding amount from the reference sample. The newly claimed invention is now drawn to a distinct method that differs in scope, objective and method steps from the method originally presented in application Serial No. 10/813,412

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 8 and 10-12 are withdrawn from consideration as being directed to a non-elected invention. See 37 C.F.R. 1.142(b) and M.P.E.P. 821.03.

3. The amendment filed September 10, 2007 amending all of the claims to an invention not originally presented is nonresponsive (see MPEP 821.03). The remaining claims are not readable on the originally presented invention for the reasons set forth above. Applicant is given a ONE MONTH time limit or until the expiration of the response period set in the last Office action, whichever is longer, to complete the response. NO EXTENSION OF THIS TIME LIMIT WILL BE GRANTED UNDER EITHER 37 CAR 1.136(a) OR (b) but the period for response set in the last office action may be extended up to a maximum of SIX MONTHS.

4. It is also noted that the manner in which the claims have been amended is improper because the deleted portions of the claimed subject matter should be marked with a strike-through or double brackets where appropriate, see MPEP 714II-C(B).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J. Reddig whose telephone number is (571) 272-9031. The examiner can normally be reached on M-F 8:30 a.m.-5:00 p.m.

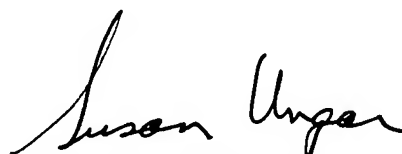
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms can be reached at (571) 272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Peter J. Reddig  
Examiner  
Art Unit 1642



SUSAN UNGAR, PH.D  
PRIMARY EXAMINER

PJR